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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,382	11/15/2000	Clayton A. George	54680USA8B.008	4594

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EXAMINER

CHANG, VICTOR S

ART UNIT PAPER NUMBER

1771

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DATE MAILED: 05/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/713,382

Applicant(s)

GEORGE ET AL.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 and 30 is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☒ Claim(s) 21-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Rejections not maintained are withdrawn. In particular, applicants' argument regarding claims 21-30 as "consonant in scope" to original claims 11-20 appears persuasive, and as such the rejection under obviousness-type double patenting is withdrawn.

Response to Amendment

3. Claims 11-20 are rejected under 35 U.S.C. 103(a) as being obvious over Johnson et al. (US 6284360) in view of Sekisui Chemical Co. (JP 10195393), substantially for the reasons set forth in section 4 of Paper No. 14, section 3 of Paper No. 11, section 10 of Paper No. 9 and section 6 of Paper No. 5, together with the following additional observations.

With respect to Applicants' argument that the present invention and Johnson were both owned by the 3M Company, and the present invention was filed after November 29, 1999 and is a continuing application filed under 37 CFR 1.53(b), the Examiner has the following observations. First, the Examiner reiterate that there is no assignee for US Application No. 09/713382 on the record. Second, US Application No. 09/713382 is a divisional application of US Application No. 09/409502, and neither 09/713382 nor 09/409502 is a continuing application of 08/941430, of which the

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reference Johnson (US 6284360) is based upon. As such, Johnson is an appropriate prior art under 35 USC 103(a) to the instant claimed invention.

With respect to Applicants' argument that there is no disclosure, teaching or suggestion in Johnson, Sekisui '393, or the combined teaching of Johnson with Sekisui that would motivate the person of ordinary skill in the art to substitute a multi-layered pressure sensitive adhesive laminate for the sealant layer in the articles of Johnson (Response, page 5, first paragraph), the Examiner reiterates that both Sekisui's and Johnson's inventions are directed to the same field of endeavor, that is a curable (e.g., thermoset) sealant for jointing members. As such, it would have been obvious to one of ordinary skill in the art to combine the teachings of Sekisui and Johnson (see section 4 of Paper No. 14 and section 3 of Paper No. 9).

With respect to Applicants' argument that the Johnson expressly teaches away from the proposed substitution suggested by Examiner, and Johnson specifically excludes pressure sensitive compositions as suitable sealant layer materials (Response, page 5, paragraphs 1-3), the Examiner reiterates (see section 4 of Paper No. 14) that while Applicants may be his or her own lexicographer, it is noted that Johnson also appear to be limiting the definition of the "pressure sensitive adhesive" to un-cured adhesives (column 2, lines 7-21), whereas Sekisui is directed to a "curable sticking sheet for jointing members" (Derwent Abstract of JP 10195393), which is clearly consistent with the definition of "thermosetting sealant compositions" provided by Johnson (column 2, lines 2-6 and 22-31). As such, it would have been obvious to one of ordinary skill in the art of thermosetting sealant to substitute Johnson's adhesive

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layer, motivated by the desire to obtain an excellent initial adhesive strength imparted by the difference in curing rate, as taught by Sekisui.

In response to Applicants' argument that "the only motivation for such a combination of teachings has been deemed from a review of Applicants' invention" (Response, page 6, second complete paragraph), the Examiner notes that it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

4. Claims 21-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Claims 29 and 30 are allowed.

6. This is a continuation of applicant's earlier Application No. 09713382. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC
May 12, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300-

1700

Daniel Zinker